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TRANSMITTAL FORM

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First Named Inventor	Harrington et al.
Examiner Name	Tekchand Saidha
Group Art Unit	1652
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Attorney Docket No.	RI-71904 / 470438-7

ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Deposit Account Authorization 50-2319	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input checked="" type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment / Reply	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input checked="" type="checkbox"/> Petition Under 37 CFR § 1.181 Requesting Reconsideration Of Decision Denying Petition To Expunge An Improperly Entered Third Party Protest	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation, Change of Correspondence Address	<input checked="" type="checkbox"/> Return Postcard
<input type="checkbox"/> Express Mail No.:	<input type="checkbox"/> Terminal Disclaimer	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
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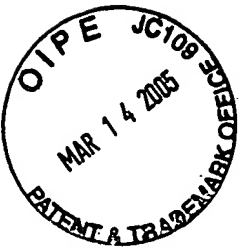
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

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Date	March 11, 2005	

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PATENT

Attorney Docket No. RI- 71904

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Examiner: Tekchand Saidha

Harrington et al.

Serial No. 09/586,744

Art Unit: 1652

Filed: June 2, 2000

Confirmation No. 7865

Title: MAMMALIAN FLAP-SPECIFIC ENDONUCLEASE

**PETITION UNDER 37 C.F.R. § 1.181 REQUESTING RECONSIDERATION OF
DECISION DENYING PETITION TO EXPUNGE AN IMPROPERLY ENTERED
THIRD PARTY PROTEST**

ATTN: DIRECTOR BRUCE KISLIUK
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

I. RELIEF REQUESTED

Petitioner requests reconsideration of the decision of the Director, Technology Center 1600 issued January 13, 2005 denying its Petition under 37 CFR §1.181 to Expunge an Improperly Entered Third Party Protest filed October 5, 2004.

II. STATEMENT OF FACTS

The captioned reissue application was filed on June 6, 2000 based on U.S. Patent Number 5,874,283, issued February 23, 1999. To date, three Third Party Protests have been filed by the same party: the first on January 3, 2001 "the "First Protest"), a second on January 9, 2002 (the "Second Protest"), and a third on August 13, 2004 (the "Third Protest"). Each of the protests has been entered into the record of the instant reissue application. Petitioner submitted a Response to the First Protest on February 14, 2001, rebutting its merits. A Response to the Second Protest stating that it was improperly entered, and pointing out its lack of merit, was filed on May 22, 2002. On October 5, 2004, Petitioner submitted a Petition under 37 CFR §1.181 (the "Petition") requesting that the Third Protest be expunged

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from the record of the instant application on the grounds that it does not comply with 37 CFR § 1.291(c). The Petition was denied in a Decision dated January 13, 2005 (the "Decision"). Reconsideration of this Decision is requested.

III. ARGUMENT

The Decision acknowledges that the protest filed on August 13, 2004 is the *third* protest submitted by the same party, yet denies Petitioner's request to have it expunged from the record, because the "issues raised...form the basis of at least part of the Office Action mailed September 1, 2004, thus indicating its value is the determination of patentability." Petitioner submits that the merits of the Third Protest regarding patentability are not germane to the issue at hand. What *is* germane is whether the Third Protest complies with the rules of practice.

As pointed out in the Petition, the rules of practice very clearly state that the involvement of a member of the public filing a protest *ends with the filing of the protest*, and that *no further submissions on behalf of the protestor will be considered* unless the submission raises new issues that could not have been presented earlier. To this end, 37 CFR § 1.291(c) states in pertinent part:

The limited involvement of the member of the public filing a protest pursuant to paragraph (a) of this section ends with the filing of the protest, and no further submission on behalf of the protestor will be considered, except for additional prior art, or unless such submission raises new issues which could not have been earlier presented.

37 CFR §1.291(c) (2004). The MPEP makes abundantly clear that arguments relating to an Office Action or an applicant's reply *do not raise new issues*:

For example, mere arguments relating to an office action or an applicant's reply *would not qualify as a new issue*.

MPEP § 1901.07(a) (emphasis supplied). Thus, supplemental submissions that present arguments relating to Office Actions or an applicant's response violate 37 CFR § 1.291(c), and should not be entered into the record:

Protests which will not be entered in the application file includes those further submissions in violation of 37 CFR § 1.291(c) by which the protestor seeks to participate in the examination process.

Id. This prohibition on entry is not limited to supplemental submissions, but also includes new protests. Specifically, MEP § 1901.07(a) states in pertinent part:

Even new protests *which also argue Office actions or replies or any matter beyond the new issue* should not be accepted.

Id. Thus, new protests that also argue Office actions or replies, or that include any arguments in addition to new issues that could not have been raised earlier, are considered improper.

By the Protestor's own admission, their Third Protest does not raise new issues. It merely responds to arguments and amendments made by the Petitioner:

The present communication addresses five new issues *based on the Applicant's arguments to the patent office....*"

Third Protest at page 3 (emphasis supplied). Even assuming, *arguendo*, the Third protest raises an issue that could be considered "new," it includes arguments relating to Petitioner's response to the Patent Office, and therefore includes matter beyond any possible "new" issue. Accordingly, whether viewed as a supplemental submission or as a new protest, the Third Protest violates the rules of practice and should not have been entered into the record:

Improper protests will be refused consideration and returned by the Technology Center (TC) Director.

Id.

The Decision states that decisions regarding entry of protests rests on multiple factors, one of which is whether the issues raised have an impact on patentability. Petitioner can find no basis in the rules of practice supporting this proposition.

As evidenced by the above discussion, the rules of practice governing the entry of supplemental and/or subsequent protests are clear. Under the rules, the Third Protest (and also the Second Protest), should not have been entered into the instant application because it violates 37 CFR § 1.291(c).

Since the Decision appears to apply a standard not contemplated by the rules of practice, reconsideration of the Decision in light of the proper standard is respectfully requested. Specifically, Petitioner again requests that the Third Protest be expunged from the record on the ground that it violates 37 CFR § 1.291(c). Moreover, since the Office Action mailed September 14, 2004 incorporates information that should have never been considered in the first place, Petitioner also reiterates its request that this Office Action be withdrawn.

Petitioner also notes for the record that granting its original Petition is not only consistent with the rules of practice, it is consistent with the policy considerations underlying the rules. Indeed, in 1982, Rule 291(c) was explicitly amended to prevent the very behavior occurring in the instant case: attempts by third party adversaries to prolong the time and cost of examination by participating *inter parte*, under the guise of the protest process, in the *ex parte* examination process. See, e.g., *In re Blaese*, 19 USPQ2d 1232, 1235 (Comr Pats 1991) and 47 Fed. Reg. 21746.

The amendment to Rule 291(c) was specifically designed to ensure that examination proceedings are essentially *ex parte*. 47 Fed. Reg. at 21749, Col. 2. Moreover, the Patent Office explained in the notice proposing to amend Rule 291 that the proposed rule change was designed to reduce the prosecution costs of patent applicants by limiting the amount of participation by protestors during the patent application examining process. 46 Fed. Reg. 55666, Col. 2 (Nov. 10, 1981).

Thus, the rules regulating third party protests fully contemplated, and were specifically amended to protect against, the prejudicial and disruptive effect that permitting members of the public to participate *inter partes* in the *ex parte* examination process would have on patent applicants. If these rules are ignored, Petitioner will be subjected to the very behavior the rules were designed to prohibit.

IV. CONCLUSION

In view of the foregoing, Petitioner requests that the Decision be reconsidered and that the Third Protest be expunged from the record. In addition, Petitioner requests that a new final Office Action be issued that is untainted by an interested third party's improperly entered views.

Submitted with this paper is the required fee set forth in 37 CFR 1.17(f). Petitioner submits that the Petition is timely filed and believes that no other fees are due. However, the Commissioner is authorized to charge additional fees which may be required, including extension fees, or credit any overpayment, to Deposit Account No. 50-2319 (Our Order No. 470438-0007).

Please direct any telephone calls concerning this application to the undersigned attorney at (415) 781-1989.

Respectfully submitted,

DORSEY & WHITNEY LLP

Dated: March 11, 2005

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